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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,652	02/26/2002	Katsumi Yabusaki	K036-4537(PCT)	3872
7590	04/27/2004			
Adams & Wilks 50 Broadway 31st Floor New York, NY 10004			EXAMINER HANNAHER, CONSTANTINE	
			ART UNIT 2878	PAPER NUMBER

DATE MAILED: 04/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/069,652	Applicant(s) YABUSAKI ET AL.	
	Examiner Constantine Hannaher	Art Unit 2878	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 4-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsui *et al.* (EP0926482A3) in view of Slovacek *et al.* (US005242837A) and Bromberg (US0041055768A).

With respect to independent claim 4, Matsui *et al.* discloses an apparatus of the recited type comprising all the elements set forth but for the “second illumination means” and the “switching means.” See the explanation of the rejection of claim 1 as set forth in the prior Office action. Slovacek *et al.* shows (Fig. 3) that irradiation with exciting light from a lamp 34 at the bottom 12 of a container 16 from the bottom is known. Slovacek *et al.* does not appear to explain why the disclosed apparatus irradiates from the bottom, but Bromberg explains (at column 1, lines 55-59) that so-called “front face” excitation illumination is useful for direct analysis of samples without dilution.

Since Matsui *et al.* and Slovacek *et al.* are both in the art of blood analysis, as is Bromberg, and the elimination of the dilution step suggested by Bromberg would have been recognized as useful in that art, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Matsui *et al.* to comprise a second illumination means for irradiating the bottom of the imaging container **3** from the bottom with the exciting light in view of the improved flexibility in being able to analyze undiluted blood samples as well as preparations from whole blood. A switching means for switching between the side face and front face modes (illumination means) in such a modified apparatus would have been obvious in view of the need to adjust the apparatus to accommodate the particular sample in imaging container **3**.

With respect to dependent claims 5 and 6, the form of the switching means suggested by the combination of Matsui *et al.*, Slovacek *et al.*, and Bromberg is a choice within the ordinary skill in the art. An optical element (for example, a mirror) or a switch of exciting light sources are well known expedients for delivering light to multiple locations (as in scanners, for example).

With respect to dependent claim 7, the first illumination means disclosed by Matsui *et al.* operates in the recited manner, the second illumination means suggested by Slovacek *et al.* and Bromberg operates in the recited manner.

With respect to dependent claim 8, the first illumination means disclosed by Matsui *et al.* operates in the recited manner.

With respect to independent claim 9, Matsui *et al.* discloses an apparatus of the recited type comprising an imaging container with the requisite sections and walls and the recited exterior surface portion defining a first entry surface corresponding to the side wall for the recited purpose, a light projecting means for projecting an excitation beam of light onto the first entry surface of the imaging container for the recited purpose, and means for capturing images of illuminated

fluorescent particles from the bottom wall of the imaging container. Although the apparatus of Matsui *et al.* does not describe the bottom wall of the imaging container as a second entry surface, as a one-piece molding of polystyrene resin, the imaging container **3** and its bottom wall is completely adequate for passing an excitation beam of light. Slovacek *et al.* shows (Fig. **3**) that irradiation with exciting light from a lamp **34** at the bottom **12** of a container **16** from the bottom is known. Slovacek *et al.* does not appear to explain why the disclosed apparatus irradiates from the bottom, but Bromberg explains (at column 1, lines 55-59) that so-called “front face” excitation illumination is useful for direct analysis of samples without dilution. Since Matsui *et al.* and Slovacek *et al.* are both in the art of blood analysis, as is Bromberg, and the elimination of the dilution step suggested by Bromberg would have been recognized as useful in that art, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Matsui *et al.* to selectively project the exciting light onto the lower section of the imaging container **3** from the bottom in view of the improved flexibility in being able to analyze undiluted blood samples as well as preparations from whole blood, *i.e.*, to accommodate the particular sample in imaging container **3**.

With respect to dependent claim 10, the form of the light projecting means suggested by the combination of Matsui *et al.*, Slovacek *et al.*, and Bromberg is a choice within the ordinary skill in the art. An optical element (for example, a mirror) is a well known expedient for delivering light to multiple locations (as in scanners, for example).

With respect to dependent claim 11, the light projecting means disclosed by Matsui *et al.* operates in the recited manner.

With respect to independent claim 12, this independent claim differs from independent claim 9 only in its recitation of what the interior space of the imaging container might contain.

Matsui *et al.* is considered to disclose fluorescent particles of the “first” recited type, and Slovacek *et al.* especially in view of Bromberg is considered to disclose fluorescent particles of the “second” recited type. In view of the need to adjust the device to accommodate the particular sample in imaging container 3 (diluted or undiluted) it would have been obvious to one of ordinary skill in the art at the time the invention was made that the light projecting means suggested by the combination of references would illuminate an entry surface in accordance with the contents of the imaging container 3.

With respect to dependent claim 13, the form of the light projecting means suggested by the combination of Matsui *et al.*, Slovacek *et al.*, and Bromberg is a choice within the ordinary skill in the art. An optical element (for example, a mirror) is a well known expedient for delivering light to multiple locations (as in scanners, for example).

With respect to dependent claim 14, the light projecting means disclosed by Matsui *et al.* operates in the recited manner.

With respect to dependent claim 15, the first fluorescent particles described by Matsui *et al.* are fairly identified as one of the recited derivatives (paragraph [0025]).

With respect to dependent claim 16, in view of the explanation by Bromberg at column 1, lines 55-59 and the description by Slovacek *et al.* of the third and fourth examples, the second fluorescent particles suggested by Slovacek *et al.* and Bromberg are fairly identified as the recited derivative.

Response to Submission(s)

4. The amendment filed April 5, 2004 has been entered. The amendment to the specification sets forth “state” when --stage-- might have been expected.

5. Applicant's arguments filed April 5, 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Accordingly, the discussion of Matsui *et al.* from page 27 ("The prior art of record does not...") to page 29 ("...clearly not disclose or suggested by Matsui."), and the similar discussions of Slovacek *et al.* and Bromberg, is irrelevant.

The proposed combination on page 30 is nonsensical. Has applicant's representative forgotten their vigorous insistence that an apparatus according to Matsui *et al.* can *only* irradiate the first entry surface? Why would this be lost if irradiation of the second entry surface was added to the apparatus?

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, applicant's representative has improperly limited the location of the teaching, suggestion, or motivation to a *particular* reference and furthermore has chosen to paraphrase but otherwise ignore the Examiner's statement.

For at least the reasons explained above, Applicant is not entitled to a favorable determination of patentability in view of the arguments submitted April 5, 2004.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Constantine Hannaher whose telephone number is (571) 272-2437. The examiner can normally be reached on Monday-Friday with flexible hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Porta can be reached on (571) 272-2444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2878

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Constantine Hannaher
Primary Examiner